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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,361	02/06/2006	Dirk Broell	284635US0PCT	9860

22850 7590 06/22/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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ZUCKER, PAUL A

ART UNIT	PAPER NUMBER
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1621

NOTIFICATION DATE	DELIVERY MODE
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06/22/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/567,361	<b>Applicant(s)</b> BROELL, DIRK	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/2006</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: A section headed Brief Description of the Drawing(s) is missing. See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Holdstock et al (WO 00/63149-A1 10-2000). Holdstock discloses (Page 19, line 9 – page 20, line 6) a process for the synthesis of glyceryl methacrylate from the corresponding dioxolane derivative in the presence of an ion exchange resin in (Amberlyst 15) in a glass reactor with a slow stream of filtered air passing through it. These conditions correspond to those found in a fixed bed reactor. The air stream removes volatile components water and acetone continuously to drive the reaction to completion. Holdstock discloses (Page 20, lines 22 –28) the formation of water-soluble polymer and a contact lens therefrom. Holdstock therefore anticipates claims 1 and 4-6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Holdstock et al (WO 00/63149-A1 10-2000) in view of Smitt et al (WO 03/006417-A1 01-2003; **NOTE:** For purposes of this rejection English equivalent 371 US 7,002,035 will be used).

Instantly claimed is a process for the preparation of compounds of formula (I) in the presence of an ion exchange resin and tocopherol from compounds of formula (II) and their further processing to form water-soluble polymers and contact lenses therefrom.

Holdstock teaches (Page 19, line 9 –page 20, line 6) a process for the synthesis of glyceryl methacrylate from the corresponding dioxolane derivative in the presence of

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an ion exchange resin in (Amberlyst 15) in a glass reactor with a slow stream of filtered air passing through it. These conditions correspond to those found in a fixed bed reactor. The air stream removes volatile components water and acetone continuously to drive the reaction to completion. Air serves as a polymerization inhibitor. Holdstock teaches (Page 20, lines 22 –28) the formation of water-soluble polymer and a contact lens therefrom.

The difference between the process taught by Holdstock and that instantly claimed is that Holdstock is silent with regard to inclusion of tocopherol in his process and such is instantly claimed.

Schmitt, however, teaches (Abstract) the use of a tocopherol compound for the color stabilization of hydroxyalkyl(meth)acrylates (compound of formula (I) are included in this group). Schmitt specifically teaches (Column 4, line 67) the use of tocopherols with 2,3-dihydroxypropyl methacrylate.

Thus one of ordinary skill in the art would have been motivated to add tocopherol as taught by Schmitt to the reaction mixture to form the hydroxyalkyl (meth)acrylates (I) of Holdstock in order to prevent discoloration of the monomer upon formation. It is critical to prevent this discoloration in feedstock for polymer production where the polymer is intended for optical use in the formation of contact lenses. There would have been a reasonable expectation for success based upon Schmitt's teaching.

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The Instantly claimed processes would therefore have been obvious to one of ordinary skill in the art.

***Conclusion***

4. Claims 1-6 are pending. Claims 1-6 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richter R. Johann can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'P. Zucker', with a large, stylized loop at the beginning and a horizontal line extending to the right.

Paul A. Zucker  
Primary Examiner  
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